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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,396	10/18/2001	Amr Salahieh	1001.1505101	1306

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EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,396

Applicant(s)

SALAHIEH ET AL.

Examiner

(Jackie) Tan-Uyen T. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 12-24, 34-70 and 74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13, 25-30, 71 and 75-80 is/are rejected.
- 7) ☒ Claim(s) 7-11 and 31-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 6/18/04 is acknowledged and considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 71-73, 75-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the claims recites a proximal stop mechanism for use with a guide wire but in the claim body applicants claim a guide wire and a device translatable disposed on the guide wire. It is not clear whether applicant intend to claim the proximal stop mechanism/locking mechanism including a one-way translation member/sleeve with means for releasably locking alone or a system comprising a combination of a guide wire, a device and a one-way translation member/sleeve with means for releasably locking.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 25-27, 28-30, 71-73, 78-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Khosravi (6,129,739). Khosravi disclose a guidewire (132) including a first stop mechanism (145) and a second stop mechanism (146), a filter (136) as claimed (see figure 8). In regard to claim 6, the limitation "deformable" does not impose any structural limitations on the claims distinguishable over the Khosravi's device. The stops (145, 146) are deformable (if one desired to do so, one can use any mean to deform the stops 145,146). In regard to claim 78 and 79, sleeve (143) having distal and proximal end as part of means for releasably locking the translational position of the filter translatably disposed on the guide wire and is inherently threaded along guidewire to a desired location on the guide wire before locked by the stops (145, 146).

The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the Khosravi's device which is capable of being used as claimed if one desires to do so.

Claims 71, 72, 75-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel et al. (6,171,321). In regard to claim 71, 72, 75-77, Daniel et al. disclose a proximal stop mechanism comprising a guide wire (26), a one-way translation member (62) affixed to the guide wire, the sleeve (52) being translatable over the member (62) and the member (62) capable of preventing the sleeve from translating proximally over

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the one-way translation member, member (62) including a high profile and low profile configuration.

In regard to claims 78-80, a guide wire (26), a sleeve member (274) having means (276) for releasable locking the translation position of a device (250) translatable disposed on the guide wire wherein the sleeve is inherently flexible.

Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the proximal stop mechanism of Daniel et al. which is capable of being used as claimed if one desires to do so.

Allowable Subject Matter

6. Claims 7-11, 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to disclose the deformable one-way translation member as claimed.

Response to Arguments

7. Applicant's arguments filed 6/18/04 have been fully considered but they are not persuasive. The functional limitation "is deliverable" is considered but do not impose any structural limitations on the claims distinguishable over the Khosravi's device which is capable of being used as claimed if one desires to do so. The limitation "wherein the guide wire is deliverable within a vessel independently of the embolic filter" is broadly interpreted as the guide wire by itself without the need of the filter is deliverable within a

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vessel. The guide wire of Khosravi's device by itself without out the need of the filter (if one desired to do so) is deliverable within a vessel.

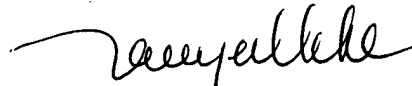
The functional limitation "translatable from a proximal end of the guide wire to a point when the open proximal end of the sheath is distal of the stop mechanism" is considered but do not impose any structural limitations on the claims distinguishable over the Khosravi's device which is capable of being used as claimed if one desires to do so. Inherently, the sheath (143) of Khosravi is translatable from proximal end of the wire guide (132) to distal end (133) of the guide wire until the stops (145 and 146) is placed at each end of the sheath.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN or NGUYEN can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Patent Examiner
Art Unit 3731

October 6, 2004